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Mail Stop Appeal Brief-Patents

Attorney Docket No. P29693

In re application of :

Peter HIMMELSBACH et al.

Confirmation No. 5165

Application No. : 09/601,029

Group Art Unit : 1771

Filed : July 26, 2000

Examiner : Piziali, Andrew T.

For : SUPPORTING MATERIAL FOR MEDICINAL PURPOSES

Mail Stop Appeal Brief- Patents

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Appeal Brief- Patents

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

Transmitted herewith is a **Supplemental Appeal Brief under 37 C.F.R. §41.37** in the above-captioned application.

 Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

 A Request for Extension of Time.

 X No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 61	*61	0	x25=	\$	x 50=	\$ 0.00
Indep. Claims: 2	**3	0	x100=	\$	x200=	\$ 0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$ 0.00
Extension Fees for <u> </u> Month(s)				\$		\$ 0.00
Notice of Appeal Filing Fee						\$ 0.00
			Total:	\$	Total:	\$ 0.00

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 Please charge my Deposit Account No. 19-0089 in the amount of \$.

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 X The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

 X Any additional filing fees required under 37 C.F.R. 1.16.

 X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter HIMMELSBACH et al.

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SECOND SUPPLEMENTED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Supplemented Appeal Brief is in response to the Notification of Non-Compliant Appeal Brief mailed June 25, 2007. Inasmuch as the one month period for reply is originally set in the Notification to expire on July 25, 2007, this Supplemented Appeal Brief is being filed by the initial due date for response. However, if any extension of time is necessary, this is an express request for any necessary extension of time and authorization to charge any required extension of time fee or any other fees which may be required to preserve the pendency of the present application to Deposit Account No. 19-0089.

The present Supplemented Appeal Brief differs from the original Appeal Brief essentially in that it contains a statement of the status of all claims and that each of the nineteen grounds of rejection to be reviewed on appeal is discussed under a separate heading.

This Appeal is from the Examiner's Final Rejection of claims 37-98 set forth in the Final Office Action mailed from the U.S. Patent and Trademark Office on August 2, 2006.

A Notice of Appeal and a Pre-Appeal Brief Request for Review in response to the August 2, 2006 Final Office Action and the Advisory Action mailed October 12, 2006 were filed on October 25, 2006.

The requisite fee under 37 C.F.R. § 41.20(b)(2) for filing the Appeal Brief (\$500.00) was paid by check when the original Appeal Brief was filed on December 26, 2006.

Inasmuch as the original Appeal Brief was filed within the one-month period from the mailing date of the Notice of Panel Decision from Pre-Appeal Brief review mailed November 30, 2006, set to expire on January 2, 2007 (December 30/31, 2006 being a Saturday/Sunday and January 1, 2007 being a holiday), it is believed that no extension of time is required. However, the Patent and Trademark Office is hereby authorized to charge any fee necessary for maintaining the pendency of this application, including any appeal or extension of time fees that may be necessary, to Deposit Account No. 19-0089.

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Beiersdorf AG of Hamburg, Germany. The assignment was recorded in the U.S. Patent and Trademark Office on July 26, 2000 at REEL 010983, FRAME 0584.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' representative or the Assignee are not aware of any other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The status of the claims is as follows:

Claims 1-36 are cancelled. Claims 37-98 are pending in this application.

Each of claims 37-98 is indicated as rejected in the Final Office Action mailed August 2, 2006.

The rejection of each of claims 37-98 is under appeal. Claims 37-98 involved in the appeal are reproduced in the Claims Appendix attached hereto.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the Final Office Action mailed August 2, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Claim 37

Independent claim 37 is drawn to a backing material for medical purposes. The backing material comprises a nonwoven, overstitched by yarns with a number of stitches of at least 3/cm of web, and an adhesive composition on at least a part of at least one side of the nonwoven. The adhesive composition is a hot melt composition which comprises one or more block copolymers wherein at least one block comprises styrene. The adhesive composition further comprises at least one pharmacologically active substance.

See, e.g., page 9, lines 3-12 in combination with page 34, lines 3-9 and 21-25, page 18, lines 3-11 as well as Examples 1 and 2 at page 30, line 32 to page 33, line 34 of the present specification.

B. Claim 69

Independent claim 69 is drawn to backing material for medical purposes. The backing material comprises a nonwoven which is reinforced by stitches formed by loops from fibers of the nonwoven, the number of stitches being at least 3/cm of web, and an adhesive composition on at least a part of at least one side of the nonwoven. The adhesive composition is a hot melt composition which comprises one or more block copolymers wherein at least one block comprises styrene. The adhesive composition further comprises at least one pharmacologically active substance.

See, e.g., page 9, lines 3-12 in combination with page 34, lines 11-25, page 10, lines 10-16 and page 18, lines 3-11 of the present specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The broad issues under consideration are:

1. Whether claims 37-43, 45-52 and 55-65 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Merkle et al., U.S. Patent No. 5,527,536 (hereafter “MERKLE”) in view of Lucast et al. U.S. Patent No. 6,479,073 (hereafter “LUCAST I”) in view of Koketsu et al., U.S. Patent No. 5,547,223 (hereafter “KOKETSU”).
2. Whether claim 44 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Bodenschatz et al., U.S. Patent No. 6,074,965 (hereafter “BODENSCHATZ”).
3. Whether claim 44 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Tomioka et al., U.S. Patent No. 4,722,857 (hereafter “TOMIOKA”).
4. Whether claims 53 and 54 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Fischer et al., U.S. Patent No. 5,863,977 (hereafter “FISCHER”).
5. Whether claim 66 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Kantner et al., U.S. Patent No. 5,489,624 (hereafter “KANTNER”).
6. Whether claim 67 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Lucast et al., U.S. Patent No. 5,407,717 (hereafter “LUCAST II”).
7. Whether claim 68 is properly rejected under 35 U.S.C. § 103(a) as allegedly being

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unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of Cilento et al., U.S. Patent No. 5,059,189 (hereafter "CILENTO").

8. Whether claims 69-73, 75-82 and 85-95 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of Wildeman et al., U.S. Patent No. 3,967,472 (hereafter "WILDEMAN").

9. Whether claim 74 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of BODENSCHATZ.

10. Whether claim 74 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of TOMIOKA.

11. Whether claims 83 and 84 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of FISCHER.

12. Whether claim 96 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of KANTNER.

13. Whether claim 97 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of LUCAST II.

14. Whether claim 98 is properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN

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and further in view of CILENTO.

15. Whether claims 37-52, 55-65, 69-82 and 85-95 are properly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of U.S. Patent No. 6,555,730 to Albrod et al. (hereafter “ALBROD”) in view of MERKLE.

16. Whether claims 53-54 and 83-84 are properly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of ALBROD in view of MERKLE and further in view of FISCHER.

17. Whether claims 66 and 96 are properly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of ALBROD in view of MERKLE and further in view of KANTNER.

18. Whether claims 67 and 97 are properly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of ALBROD in view of MERKLE and further in view of LUCAST II.

19. Whether claims 68 and 98 are properly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of ALBROD in view of MERKLE and further in view of CILENTO.

VII. ARGUMENTS

A. Summary of Rejections of Record

1. All claim rejections under 35 U.S.C. § 103(a) set forth in the final Office Action of August 2, 2006 are based on at least MERKLE in view of LUCAST I in view of KOKETSU. In this regard, the rejection alleges that MERKLE “discloses a backing material for medical purposes, and

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an adhesive composition on one side of the backing material, the adhesive composition being a hot melt composition comprising a styrene block copolymer, the adhesive composition further comprising at least one pharmacologically active substance. The rejection further alleges that MERKLE “discloses that the backing layer may be a polyester film (see Examples) but is silent with regards to specific polyester film structures” wherefore “it would have been necessary and thus obvious to look to the prior art for conventional backing layer structures”.

The rejection further alleges that LUCAST I “provides this conventional teaching showing that it is known in the art to use a nonwoven backing layer overstitched with yarns”. The rejection concedes that LUCAST I does not mention how many stitches (per cm) are present on the backing layer but asserts that KOKETSU discloses that it is known in the art that the number of stitches is a result effective variable that would alter the strength of the web, wherefore it would allegedly have been obvious to one of ordinary skill in the art “to provide 5 to 50 longitudinal stitches per cm in order to create a stitch-bonded fabric with a desired strength and rigidity”.

2. Regarding independent claim 69 the rejection appears to concede that none of MERKLE, LUCAST I and KOKETSU discloses stitches of the fabric being formed from loops from the fibers of the web but asserts that WILDEMAN allegedly discloses that it is known in the art that stitch-bonded fabrics may be stitched with the loops from the web.

3. Regarding dependent claims 39-43, 58, 59, 65, 71-73, 88-89 and 95 the rejection additionally alleges that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties”.

4. Regarding dependent claims 45, 46, 49-52, 55-57, 60, 61, 63, 75, 76, 79-82, 85-87,

90, 91 and 93 the rejection additionally alleges that the elements recited in these claims are disclosed in MERKLE.

5. Regarding dependent claim 47, 48, 77 and 78 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the weight per unit area of the adhesive on the backing material but asserts that this amount would allegedly be recognized as a result effective variable and, therefore, subject to optimization.

6. Regarding dependent claims 62 and 92 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the addition of foaming agents but asserts that LUCAST I allegedly discloses that it is known in the art to add foaming agents to an adhesive.

7. Regarding dependent claims 64 and 94 the rejection additionally alleges that the elements recited in these claims are disclosed in MERKLE, asserting that a polyester film reads on the wound pad recited therein.

8. Regarding dependent claims 44 and 74 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests reinforcing fibers in the backing layer but asserts that both BODENSCHATZ and TOMIOKA allegedly disclose that it is known in the (bandage) art to use reinforcing fibers in a backing layer or nonwoven material, respectively.

9. Regarding dependent claims 53, 54, 83 and 84 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the addition of a diblock copolymer to a hot-melt adhesive but asserts that FISCHER allegedly discloses that it is known in the art to add a diblock copolymer to a triblock copolymer adhesive to improve tack

properties and/or improve processability.

10. Regarding dependent claims 66 and 96 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the incorporation of pharmacologically active agents not in co-mixture with the adhesive but asserts that KANTNER allegedly discloses that adhesive materials in the medical field can frequently be used to transport drugs through the skin and allegedly discloses several examples of biologically active material that would exist in particle form that can be incorporated into the adhesive.

11. Regarding dependent claims 67 and 97 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests sterilizing an adhesive composition but alleges that LUCAST II discloses that adhesive tapes that are used on human skin must be sterilized.

12. Regarding dependent claims 68 and 98 the rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the incorporation of the pharmacologically active substances recited in these claims into a hot-melt adhesive but asserts that CILENTO allegedly provides a corresponding teaching and shows that it is known in the art to use pharmacologically active substances such as camphor and lidocain.

13. All claim rejections under the judicially created doctrine of obviousness-type double patenting set forth in the final Office Action of August 2, 2006 are based on at least claims 1-27 of ALBROD in view of MERKLE. In this regard, the rejection alleges that ALBROD "claims a backing material for medical purposes that is similar to the current application". The rejection concedes that ALBROD does not claim a pharmacologically active substance in the adhesive but asserts that it would allegedly have been obvious to one of ordinary skill in the art to include a pharmacologically

active substance in the adhesive as allegedly taught by MERKLE in order to provide the tape with an enhanced medical function.

14. With respect to dependent claims 53, 54, 83 and 84 the rejection concedes that MERKLE fails to disclose the addition of a diblock copolymer to a hot-melt adhesive but asserts that FISCHER allegedly discloses that it is known in the art to add a diblock copolymer to a triblock copolymer adhesive to improve tack properties and/or improve processability.

15. Regarding dependent claims 66 and 96, the rejection concedes that MERKLE fails to disclose the incorporation of pharmacologically active agents not in co-mixture with the adhesive but asserts that KANTNER allegedly discloses that adhesive materials in the medical field can frequently be used to transport drugs through the skin and allegedly discloses several examples of biologically active material that would exist in particle form that can be incorporated into the adhesive.

16. Regarding dependent claims 67 and 97, the rejection concedes that MERKLE fails to disclose sterilizing an adhesive composition but alleges that LUCAST II discloses that adhesive tapes that are used on human skin must be sterilized.

17. Regarding dependent claims 68 and 98, the rejection concedes that MERKLE fails to disclose the incorporation of the pharmacologically active substances recited in these claims into a hot-melt adhesive but asserts that CILENTO allegedly provides a corresponding teaching and shows that it is known in the art to use pharmacologically active substances such as camphor and lidocain.

B. Citation of Authority

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142. "If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned." In re Rijckaert, 9 F.3d, 1532, 28 U.S.P.Q.2d, 1956 (Fed. Cir. 1993), citing In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The appropriate starting point for a determination of obviousness is stated in Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 466 (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

The test of obviousness *vel non* is statutory and requires a comparison of the claimed subject matter as a whole with the prior art to which the subject matter pertains. In re Brouwer, 77 F.3d, 422, 37 U.S.P.Q. 2d 1663 (Fed. Cir. 1996); In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q. 2d 1127 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01.

C. Claims 37-43, 45-52 and 55-65 Are Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU

1. MERKLE Fails to Provide Motivation to Look for Other Backing Layer Structures

Claims 37-43, 45-52 and 55-65 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over MERKLE in view of LUCAST I in view of KOKETSU. In this regard, the rejection alleges that MERKLE “discloses that the backing layer may be a polyester film (see Examples) but is silent with regards to specific polyester film structures” wherefore “it would have been necessary and thus obvious to look to the prior art for conventional backing layer structures”. The rejection further alleges that LUCAST I “provides this conventional teaching showing that it is known in the art to use a nonwoven backing layer overstitched with yarns”.

Appellants submit that the assertion that MERKLE “is silent with regards to specific polyester film structures”, i.e., the only reason set forth in the Final Office Action of August 2, 2006 why one of ordinary skill in the art would allegedly be motivated “to look to the prior art for conventional backing layer structures” is clearly without merit. Each of the Examples of MERKLE specifies not only the thickness of the polyester film which is used as backing layer, but additionally even specifies the thickness of the (second) polyester film which is silicone-coated and serves as a removable protective layer. For example, in Examples 1a to 1f of MERKLE it is stated that the polyester film (backing layer) had a thickness of 70 μm and the silicone-coated polyester film had a thickness of 100 μm . In Examples 1a' and 1f' the polyester (backing) film had a thickness of 100 μm and the silicone coated polyester film had a thickness of 100 μm as well.

Appellants note that the rejection does not identify any essential information with respect to the polyester (backing) film which MERKLE fails to disclose, let alone any information whose

absence would make it impossible for one of ordinary skill in the art to successfully reproduce the Examples of MERKLE or to successfully carry out the invention of MERKLE in general. For this reason alone, there is no motivation for one of ordinary skill in the art to look for any other documents which teach backing materials for the hot-melt adhesive of MERKLE.

2. MERKLE Fails to Provide Motivation to Replace the Polyester Film Structure Disclosed Therein

Appellants further point out that all of the numerous Examples of MERKLE employ a polyester film as backing layer, which is yet another reason why one of ordinary skill in the art would not have been motivated at all to look for materials which can replace the polyester film of MERKLE. Moreover, even if one were to share, *arguendo*, the Examiner's position that one of ordinary skill in the art would have been motivated "to look to the prior art for conventional backing layer structures", this would not amount to a motivation to replace the polyester film of MERKLE with any other conventional backing material structure.

3. There is No Motivation to Combine MERKLE with LUCAST I and to Select an Overstitched Nonwoven to Replace the Polyester Film of MERKLE

Even if one were to assume, *arguendo*, that one of ordinary skill in the art would have been motivated (for some unknown reason) to replace the polyester film of MERKLE with any other conventional backing material structure, it is not seen what would have motivated one of ordinary skill in the art to consult LUCAST I and in particular, to pick and choose an overstitched nonwoven from the numerous types of backing materials disclosed by LUCAST I, i.e., a material that is neither particularly recommended by, nor used in any of the Examples of LUCAST I. In fact, the backing

materials employed in the altogether 81 exemplary articles of LUCAST I are exclusively polyester films, polyurethane films or polyurethane blown microfiber backings. In other words, the question in the present context is not whether one of ordinary skill in the art could have replaced the polyester film of MERKLE by any other backing material such as, e.g., an overstitched nonwoven, but why one of skill in the art would have done so. The Final Office Action of August 2, 2006 fails to provide any explanation in that regard.

4. LUCAST I Provides Independent Confirmation That Polyester Films are a Good Choice for the Backing Layer of the Laminate of MERKLE

The fact that polyester films are employed in several of the exemplary articles of LUCAST I may even be considered to be an independent confirmation of the impression conveyed by MERKLE, i.e., that polyester films are the most suitable and preferred backing materials of the laminate of MERKLE. In other words, the fact that LUCAST I employs polyester films as well constitutes a disincentive rather than a motivation for one of ordinary skill in the art to replace the polyester film of MERKLE by any other (conventional) backing material.

5. One of Ordinary Skill in the Art Would be Discouraged to Use a Nonwoven as Backing Layer of the Laminate of MERKLE

There is at least one reason why one of ordinary skill in the art would even be discouraged to use any nonwoven as replacement for the polyester film backing material of MERKLE: According to MERKLE, the active substance that is to be incorporated into the pressure-sensitive adhesive is a substance which, at the temperature at which the adhesive bonds, is a readily volatile liquid (see, e.g., Abstract of MERKLE). It is apparent to one of ordinary skill in the art that when using a (relatively

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porous) nonwoven instead of a (relatively dense) polyester film as backing material for the self-adhesive matrix of MERKLE there is a substantially higher risk for the active substance to evaporate through and/or ooze out of the backing material during use and/or storage of the laminate. (This is likely also the reason why the removable protective layer of the laminate of MERKLE is a polyester film as well.)

6. There is No Motivation to Combine KOKETSU with MERKLE and LUCAST I

Even if one were to assume, *arguendo*, that all of the facts set forth above are to be ignored and that one of ordinary skill in the art would indeed be motivated to replace the polyester film of MERKLE by an overstitched nonwoven as mentioned by LUCAST I, it is not seen why one of ordinary skill in the art would have been motivated to use a nonwoven that is overstitched by yarns with a number of stitches of at least 3/cm of web as it is recited in the present independent claims.

Applicants note that in this regard the rejection relies on column 7, lines 16-32 of KOKETSU which allegedly discloses “that it is known in the art that the number of stitches is a result effective variable that would alter the strength of the web, with more stitches supplying a stronger web”.

Appellants submit that there is no motivation to combine the teachings of MERKLE and LUCAST with that of KOKETSU already for the reason that KOKETSU constitutes non-analogous art.

Specifically KOKETSU does not relate to any article for use in medicine, let alone to an article for application to the skin, but to a webbing for restraining a vehicle occupant such as a safety belt (see, e.g., front page of KOKETSU), i.e., a completely different article. Not only does an article for use in medicine have nothing to do with an article such as a safety belt; a webbing as disclosed by

KOKETSU is also the opposite of a nonwoven.

7. A Combination of MERKLE/LUCAST I with KOKETSU Does Not Result in a Motivation to Provide the Claimed Subject Matter

Even if one were to assume, *arguendo*, that there is motivation to combine the teaching of KOKETSU with the (combined) teachings of MERKLE and LUCAST I, this combination would not result in a motivation to provide the subject matter of independent claim 37 (and any of the claims dependent therefrom). In particular, present independent claim 37 recites, *inter alia*, that the backing material comprises a nonwoven, overstitched by yarns with a number of stitches of at least 3/cm of web. MERKLE and LUCAST I are completely silent in this respect. Further, the passage of KOKETSU which is relied on in this regard in the Final Office Action of August 2, 2006, i.e., column 7, lines 16-32 does not even mention the number of stitches per unit length (of a webbing). In particular, this passage states, apparently with reference to Figure 1 of KOKETSU (emphases added):

In the first sewn-together portion A1, there are three stitch rows and the load is reduced in three stages. Therefore, this structure is effective in preventing a sudden decrease in the load applied between the vehicle occupant 26 and the webbing 12 when the length of the webbing 12 is increased. However, the number of stitch rows is not limited to three. Any number of stitch rows may be formed, and further, the operational effects of the present invention do not deteriorate even if only one row is provided.

In the first sewn-together portion A1, the respective lengths of the stitch rows are different. Accordingly, by varying the number of stitches, the respective sewing strengths of the stitch rows is varied. However, the present invention is not limited to the same, and the respective stitch rows may be formed by sewing threads having different break-resistant strengths.

Accordingly, all that is mentioned in this passage is the number and length of stitch rows and the number of stitches in relation to the length of the stitch rows, i.e., not the number of stitches per unit length as recited in present claim 37. In other words, KOKETSU discloses that the length of the

stitch rows can be varied by varying the number of stitches which constitute the stitch rows (which is evident, anyway) and appears to imply that the longer a stitch row, the higher is the sewing strength provided thereby. KOKETSU clearly does not teach or suggest that the sewing strength should or can be improved by increasing the number of stitches per unit length (e.g., per cm).

The facts set forth above constitute yet another reason why the Examiner has failed to establish a *prima facie* case of obviousness of claims 37-43, 45-52 and 55-65 over MERKLE in view of LUCAST I in view of KOKETSU.

D. Claims 69-73, 75-82 and 85-95 Are Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN

Independent claim 69 differs from independent claim 37 discussed above in Section VI.C. essentially only in that it recites that the nonwoven is reinforced by stitches formed by loops from fibers of the nonwoven, the number of stitches being at least 3/cm of web, whereas claim 37 recites that the nonwoven is overstitched by yarns with a number of stitches of at least 3/cm of web. The rejection of claims 69-73, 75-82 and 85-95 in the Final Office Action of August 2, 2006 is very similar to the rejection of claims 37-43, 45-52 and 55-65, but additionally relies on WILDEMAN, alleging that Wildeman discloses “that it is known in the art that stitch-bonded fabrics may be stitched with the loops from the web” wherefore it would allegedly “have been obvious to one of ordinary skill in the art ... to stitch the fabric of [LUCAST I] with loops from the web, as disclosed by Wildeman, in order to avoid using extra stitching thread”. Final Office Action of August 2, 2006, paragraph bridging pages 10 and 11.

Appellants submit that the rejection of claims 69-73, 75-82 and 85-95 is without merit for at

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least all of the reasons set forth above in Section VI.C. with respect to the rejection of claims 37-43, 45-52 and 55-65.

Additionally, it is pointed out that even if it were assumed, *arguendo*, that WILDEMAN discloses “that it is known in the art that stitch-bonded fabrics may be stitched with the loops from the web”, this fact alone does not provide motivation to apply this knowledge to the overstitched nonwoven mentioned in LUCAST I, let alone in order to avoid using extra stitching thread.

In particular, according to the Abstract of WILDEMAN, a fleece fabric is produced by first consolidating a fleece into a primary fabric by fleece knitting, and then stitch bonding the primary fabric with warp yarn. This fabric is stated to be at least as strong and stable as ordinary stitch bonded fabrics, but has substantially improved pilling and abrasion resistance, and a much wider range of patterning and surface texture possibilities.

Appellants fail to see why improved pilling and abrasion resistance and a much wider range of patterning and surface texture possibilities would motivate one of ordinary skill in the art to employ the technique described in WILDEMAN for a backing material for medical purposes as recited in the rejected claims. In this regard, it is noted that the only uses for corresponding fabrics mentioned in WILDEMAN are as curtains, apparels, furnishing fabrics, fabrics for polyvinylchloride coated fabrics and electrode pockets in lead-acid storage batteries (col. 5, lines 52-53 and col. 6, lines 10-14).

This is yet another reason why the Examiner has failed to establish a *prima facie* case of obviousness of claims 69-73, 75-82 and 85-95 over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN.

E. SUMMARY

To sum up, for at least all of the foregoing reasons, MERKLE in view of LUCAST I in view of KOKETSU fails to teach or suggest a backing material as recited in present independent claim 37, and for at least all of the foregoing reasons MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN fails to teach or suggest a backing material as recited in present independent claim 69. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the subject matter of present independent claims 37 and 69 and any of the claims dependent therefrom.

F. Claim 44 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of BODENSCHATZ

Claim 44 is dependent from claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C. above. Accordingly, claim 44 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of BODENSCHATZ for at least all of the reasons set forth above in Section VII. C. as well.

G. Claim 44 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of TOMIOKA

Claim 44 is dependent from claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C. above. Accordingly, claim 44 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of TOMIOKA for at least all of the reasons set forth above

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in Section VII. C. as well.

H. Claims 53 and 54 are Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of FISCHER

Claims 53 and 54 are ultimately dependent from independent claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C. above. Accordingly, claims 53 and 54 are not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of FISCHER for at least all of the reasons set forth above in Section VII. C. as well.

I. Claim 66 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of KANTNER

Claim 66 is dependent from claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C. above. Accordingly, claim 66 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of KANTNER for at least all of the reasons set forth above in Section VII. C. as well.

J. Claim 67 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of LUCAST II

Claim 67 is dependent from claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C.

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above. Accordingly, claim 67 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of LUCAST II for at least all of the reasons set forth above in Section VII. C. as well.

K. Claim 68 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU and Further in View of CILENTO

Claim 68 is dependent from claim 37. Claim 37 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU for at least all of the reasons set forth in Section VII. C. above. Accordingly, claim 68 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU and further in view of CILENTO for at least all of the reasons set forth above in Section VII. C. as well.

Additionally, claim 68 recites that the nonwoven backing material recited in claim 37 comprises at least one pharmacologically active substance which is selected from the pharmacologically active substances recited in claim 68. The rejection appears to concede that none of MERKLE, LUCAST I and KOKETSU teaches or suggests the incorporation of any of the pharmacologically active substances recited in claim 68 into a hot-melt adhesive, but alleges that MERKLE “appears to be silent with regards to specific pharmacologically active substances, therefore, it would have been necessary and thus obvious to look to the prior art for conventional pharmacologically active substances” and asserts that CILENTO allegedly provides a corresponding teaching and shows that it is known in the art to use pharmacologically active substances such as camphor and lidocain. Final Office Action of August 2, 2006, page 9, second paragraph.

Appellants submit that MERKLE is not silent at all with regard to specific pharmacologically

active substances that are to be incorporated into the self-adhesive matrix disclosed therein. For example, in col. 4, lines 21-26, MERKLE specifies the active substances as “low-melting and/or volatile active ingredients, especially of nicotine and of β -receptor blockers, such as bupranolol”. Nicotine and bupranolol are also the specific active substances which are employed in the Examples of MERKLE.

In view of the foregoing, it would not have been necessary for one of ordinary skill in the art “to look to the prior art for conventional pharmacologically active substances”, which is the only reason alleged by the Examiner as to why one of ordinary skill in the art would be motivated to combine the (combined) teachings of MERKLE, LUCAST I and KOKETSU, with that of CILENTO. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU renders obvious the subject matter of independent claim 37, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of claim 68.

L. Claim 74 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of BODENSCHATZ

Claim 74 is dependent from claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claim 74 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of BODENSCHATZ for at least all of the reasons set forth above in Section VII. D. as well.

M. Claim 74 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of TOMIOKA

Claim 74 is dependent from claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claim 74 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of TOMIOKA for at least all of the reasons set forth above in Section VII. D. as well.

N. Claims 83 and 84 are Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of FISCHER

Claims 83 and 84 are ultimately dependent from independent claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claims 83 and 84 are not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of FISCHER for at least all of the reasons set forth above in Section VII. D. as well.

O. Claim 96 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of KANTNER

Claim 96 is dependent from claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claim 96 is not rendered unpatentable over

MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of KANTNER for at least all of the reasons set forth above in Section VII. D. as well.

P. Claim 97 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of LUCAST II

Claim 97 is dependent from claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claim 97 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of LUCAST II for at least all of the reasons set forth above in Section VII. D. as well.

Q. Claim 98 is Not Properly Rejected under 35 U.S.C. § 103(a) As Being Unpatentable Over MERKLE in View of LUCAST I in View of KOKETSU in View of WILDEMAN and Further in View of CILENTO

Claim 98 is dependent from claim 69. Claim 69 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN for at least all of the reasons set forth in Section VII. D. above. Accordingly, claim 98 is not rendered unpatentable over MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN and further in view of CILENTO for at least all of the reasons set forth above in Section VII. D. as well.

Additionally, claim 98 recites that the nonwoven backing material recited in claim 69 comprises at least one pharmacologically active substance which is selected from the pharmacologically active substances recited in claim 98. The rejection appears to concede that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests the incorporation of

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any of the pharmacologically active substances recited in claim 98 into a hot-melt adhesive, but alleges that MERKLE “appears to be silent with regards to specific pharmacologically active substances, therefore, it would have been necessary and thus obvious to look to the prior art for conventional pharmacologically active substances” and asserts that CILENTO allegedly provides a corresponding teaching and shows that it is known in the art to use pharmacologically active substances such as camphor and lidocain. Final Office Action of August 2, 2006, page 16, second paragraph.

Appellants submit that MERKLE is not silent at all with regard to specific pharmacologically active substances that are to be incorporated into the self-adhesive matrix disclosed therein. For example, in col. 4, lines 21-26, MERKLE specifies the active substances as “low-melting and/or volatile active ingredients, especially of nicotine and of β -receptor blockers, such as bupranolol”. Nicotine and bupranolol are also the specific active substances which are employed in the Examples of MERKLE.

In view of the foregoing, it would not have been necessary for one of ordinary skill in the art “to look to the prior art for conventional pharmacologically active substances”, which is the only reason alleged by the Examiner as to why one of ordinary skill in the art would be motivated to combine the (combined) teachings of MERKLE, LUCAST I, KOKETSU and WILDEMAN with that of CILENTO. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU in view of WILDEMAN renders obvious the subject matter of independent claim 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of claim 98.

R. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 39-41 and 71

Claims 39-41 (which depend directly or indirectly from claim 37) and claim 71 (which depends from claim 69) recite an ultimate tensile strength of the nonwoven backing material recited in the independent claims of at least 10 N/cm, from 20 N/cm to 450 N/cm, and from 30 N/cm to 250 N/cm, respectively. None of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests any ultimate tensile strength of a nonwoven, let alone of an overstitched or reinforced nonwoven. In fact, MERKLE and KOKETSU do not even mention nonwovens.

Appellants note that the Examiner takes the position that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties” (Final Office Action of August 2, 2006, page 4, second paragraph and page 11, second paragraph).

Appellants fail to see where in MERKLE, LUCAST I, KOKETSU and WILDEMAN a stitch-bonded polyester nonwoven with 5-50 stitches per cm is taught or suggested. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 39-41 and 71.

S. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 42 and 73

Claim 42 (which depends from claim 37) and claim 73 (which depends from claim 69) recite that fibers of the nonwoven backing material recited in claims 37 and 69 exhibit a water retention capacity of from 3 % to 50 %. None of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests any water retention capacity of fibers of a nonwoven, let alone of an overstitched or reinforced nonwoven. In fact, MERKLE and KOKETSU do not even mention nonwovens.

Appellants note that the Examiner takes the position that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties” (Final Office Action of August 2, 2006, page 4, second paragraph and page 11, second paragraph).

Appellants fail to see where in MERKLE, LUCAST I, KOKETSU and WILDEMAN a stitch-bonded polyester nonwoven with 5-50 stitches per cm is taught or suggested. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 42 and 73.

T. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU Does Not Render Obvious the Subject Matter of Dependent Claims 43

Claims 43 (which depends from claim 40 which in turn depends from claim 37) recites that the nonwoven backing material recited in claim 37 exhibits an ultimate tensile stress elongation of

less than 40 % (and by virtue of the dependency from claim 40, an ultimate tensile strength of from 20 N/cm to 450 N/cm). None of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests any ultimate tensile stress elongation (and ultimate tensile strength) of a nonwoven, let alone of an overstitched nonwoven. In fact, MERKLE and KOKETSU do not even mention nonwovens.

Appellants note that the Examiner takes the position that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties” (Final Office Action of August 2, 2006, page 4, second paragraph and page 11, second paragraph). Appellants fail to see where in MERKLE, LUCAST I, KOKETSU and WILDEMAN a stitch-bonded polyester nonwoven with 5-50 stitches per cm is taught or suggested. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU renders obvious the subject matter of independent claim 37, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of claim 43.

U. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 47, 48, 77 and 78

Claims 47 and 48 (which depend from claim 37) and claims 77 and 78 (which depend from claim 69) recite that the backing material recited in claims 37 and 69 comprises the adhesive composition in an amount of more than 15 g/m² and in an amount from 90 g/m² to 500 g/m², respectively. The rejection appears to acknowledge that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests a weight per unit area of an adhesive on a (nonwoven) backing

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material but alleges that “the amount of adhesive is a result effective variable that would affect the degree of adhesion the tape would have to the skin”. Final Office Action of August 2, 2006, page 4, last paragraph and page 11, last paragraph.

Appellants fail to see where in the prior art it is taught or suggested that the amount of adhesive is a result effective variable that would affect the degree of adhesion. It would appear that in the case of a backing material of the type recited in the present claims the complete coverage of one side of the nonwoven with adhesive is sufficient for achieving optimum adhesion to the skin and that any amount of adhesive that exceeds the amount that is necessary for complete coverage will not significantly increase the degree of adhesion.

Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 47, 48, 77 and 78.

V. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 58, 59, 88 and 89

Claims 58 and 59 (which depend from claim 37) and claims 88 and 89 (which depend from claim 69) recite that the adhesive composition on the nonwoven backing material recited in claims 37 and 69 exhibits a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of lower than 15°C and from 3°C to -30°C, respectively. In this regard, the explanations at pages 19 to 21 of the present specification may be referred to. None of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests any dynamic-complex glass transition temperature of an adhesive

composition, let alone of an adhesive composition as recited in present claims 37 and 69.

Appellants note that the Examiner takes the position that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties” (Final Office Action of August 2, 2006, page 4, second paragraph and page 11, second paragraph).

Appellants fail to see where in MERKLE, LUCAST I, KOKETSU and WILDEMAN a stitch-bonded polyester nonwoven with 5-50 stitches per cm is taught or suggested. Also, it is not seen what the relationship between a stitch-bonded polyester nonwoven with 5-50 stitches per cm and the dynamic-complex glass transition temperature of an adhesive composition in contact with the nonwoven would be, and neither does the present Office Action offer any explanation in this regard.

Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 58, 59, 88 and 89.

W. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 64 and 94

Claim 64 (which depends from claim 37) and claim 94 (which depends from claim 69) recite that the backing material recited in claims 37 and 69 further comprises a wound pad or padding on the adhesive composition. The rejection appears to acknowledge that none of MERKLE, LUCAST I, KOKETSU and WILDEMAN teaches or suggests corresponding subject matter but alleges that

MERKLE “discloses that the backing material may further comprise a polyester film (considered to read on the claimed wound pad) on the adhesive composition (see Examples)”. Final Office Action of August 2, 2006, page 6, second paragraph and page 13, first paragraph.

Appellants respectfully submit that it is apparent that the polyester film on the adhesive composition in the Examples of MERKLE cannot be equated to a wound pad or padding at all. For example, in col. 6, lines 6-10 of MERKLE it is stated: “The open adhesive surface of the laminate thus obtained, consisting of adhesive film and backing layer, is then laminated to a 100 μ m thick polyester film silicone-coated on both sides (= removable protective layer).”

Apparently, the silicone-coated polyester film of MERKLE is neither intended nor suitable for use as wound pad. Specifically, it is not seen that an extremely thin (100 μ m = 0.1 mm thick) film can have any padding effect. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 64 and 94.

X. Additional Reasons Why MERKLE in VIEW of LUCAST I in View of KOKETSU (in View of WILDEMAN) Does Not Render Obvious the Subject Matter of Dependent Claims 65 and 95

Claim 65 (which depends from claim 37) and claim 95 (which depends from claim 69) recite that the nonwoven backing material recited in claims 37 and 69 can be torn by hand perpendicular to an orientation of the stitches and/or in a direction of the stitches. None of MERKLE, LUCAST I, KOKETSU and WILDEMAN mentions a corresponding property of a nonwoven, let alone of an overstitched or reinforced nonwoven. In fact, MERKLE and KOKETSU do not even mention

nonwovens.

Appellants note that the Examiner takes the position that “considering that the backing material taught by the applied prior art is substantially identical to the claimed backing material (stitch-bonded polyester nonwoven with 5-50 stitches per cm), it appears that the backing material inherently possesses the claimed properties” (Final Office Action of August 2, 2006, page 4, second paragraph and page 11, second paragraph).

Appellants fail to see where in MERKLE, LUCAST I, KOKETSU and WILDEMAN a stitch-bonded polyester nonwoven with 5-50 stitches per cm is taught or suggested. Accordingly, even if one were to assume, *arguendo*, that MERKLE in view of LUCAST I in view of KOKETSU (in view of WILDEMAN) renders obvious the subject matter of independent claims 37 and 69, the Examiner has failed to establish a *prima facie* case of obviousness at least with respect to the subject matter of each of dependent claims 65 and 95.

Y. Claims 37-52, 55-65, 69-82 and 85-95 Are Not Properly Rejected Under the Doctrine of Obviousness-Type Double Patenting over Claims 1-27 of ALBROD in View of MERKLE

The rejection of claims 37-52, 55-65, 69-82 and 85-95 under the judicially created doctrine of obviousness-type double patenting set forth in the final Office Action of August 2, 2006 is based on claims 1-27 of ALBROD in view of MERKLE. In this regard, the rejection alleges that ALBROD “claims a backing material for medical purposes that is similar to the current application”. The rejection concedes that ALBROD does not claim a pharmacologically active substance in the adhesive but asserts that it would allegedly have been obvious to one of ordinary skill in the art to include a pharmacologically active substance in the adhesive as allegedly taught by MERKLE in

order to provide the tape with an enhanced medical function.

In this regard, Appellants note that according to the Abstract of MERKLE, this document discloses a patch for the controlled release of readily available volatile active substances to the skin, the patch comprising a backing layer and, bonded to it, a water-insoluble adhesive film consisting of a pressure-sensitive fusion adhesive, plus a detachable film covering the adhesive film. The patch is characterized in that the pressure-sensitive fusion adhesive contains a triple-block copolymer of polystyrene block copoly(ethylene/butylene) block polystyrene (SEBS) at a concentration of 10 to 80% by wt., and an active substance which, at the temperature at which the adhesive bonds, is a readily volatile liquid, and which is present at a concentration of 2.5 to 25% by wt. As set forth above, the only backing layer disclosed in MERKLE is a polyester film.

In comparison, independent claims 1 and 2 of ALBROD are drawn to (1) a backing material for medical purposes which is comprised of a nonwoven overstitched by yarns, wherein the ultimate tensile stress strength of the backing material is at least 30 N/cm and the backing material is coated on at least one side with a self-adhesive composition and (2) a backing material for medical purposes which is comprised of a nonwoven web which is reinforced by the formation of stitches formed by loops from the fibers of the web, the number of stitches on the web being at least 5/cm, and wherein the ultimate tensile stress strength of the backing material is at least 30 N/cm, and the backing material is coated on at least one side with a self-adhesive composition.

Appellants are unable to see how in view of the fundamental differences between MERKLE and the claims of ALBROD with respect to, e.g., the backing layers thereof one of ordinary skill in the art would be motivated to combine the claims of ALBROD with the teaching of ALBROD. Also,

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the active substance to be employed according to MERKLE, i.e., a substance which, at the temperature at which the adhesive bonds, is a readily volatile liquid, would appear to be unsuitable for use in combination with a nonwoven which is necessarily relatively porous and would be expected to allow the active substance to readily evaporate and/or escape in the form of a liquid therethrough.

In view of the foregoing, claims 1-27 of ALBROD in view of MERKLE do not render obvious the subject matter of present claims 37-52, 55-65, 69-82 and 85-95, wherefore reversal of the corresponding double patenting rejections is respectfully requested as well.

Z. Claims 53-54 and 83-84 Are Not Properly Rejected Under the Doctrine of Obviousness-Type Double Patenting over Claims 1-27 of ALBROD in View of MERKLE and Further in View of FISCHER

Claims 53 and 54 are ultimately dependent from independent claim 37 and claims 83 and 84 are ultimately dependent from independent claim 69. Claims 37 and 69 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE for at least all of the reasons set forth in Section VII. Y. above. Accordingly, claims 53-54 and 83-84 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE and further in view of FISCHER for at least all of the reasons set forth above in Section VII. Y. as well.

AA. Claims 67 and 97 Are Not Properly Rejected Under the Doctrine of Obviousness-Type Double Patenting over Claims 1-27 of ALBROD in View of MERKLE and Further in View of LUCAST II

Claims 67 and 97 are dependent from independent claims 37 and 69, respectively. Claims 37 and 69 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE for at least all of the reasons set forth in Section VII. Y. above. Accordingly, claims 67 and 97 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE and further in view of LUCAST II for at least all of the reasons set forth above in Section VII. Y. as well.

BB. Claims 68 and 98 Are Not Properly Rejected Under the Doctrine of Obviousness-Type Double Patenting over Claims 1-27 of ALBROD in View of MERKLE and Further in View of CILENTO

Claims 68 and 98 are dependent from independent claims 37 and 69, respectively. Claims 37 and 69 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE for at least all of the reasons set forth in Section VII. Y. above. Accordingly, claims 68 and 98 are not properly rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-27 of ALBROD in view of MERKLE and further in view of CILENTO for at least all of the reasons set forth above in Section VII. Y. as well.

VII. CONCLUSION

Appellants respectfully submit that for at least all of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness of any one of present claims 37-98 with respect to MERKLE in view of LUCAST I, KOKETSU, WILDEMAN and the various other documents cited in the Final Office Action of August 2, 2006, which is a prerequisite for maintaining a rejection under 35 U.S.C. § 103. The Examiner also has failed to establish that the obviousness-type double patenting rejection of claims 37-98 over claims 1-27 of ALBROD in view of MERKLE and the various other documents cited in the Final Office Action of August 2, 2006 has merit. The Board is, therefore, respectfully requested to reverse the Final Rejection, and to allow the application to issue in its present form.

Respectfully submitted,
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CLAIMS APPENDIX

37. A backing material for medical purposes, wherein the backing material comprises a nonwoven, overstitched by yarns with a number of stitches of at least 3/cm of web, and an adhesive composition on at least a part of at least one side of the nonwoven, the adhesive composition being a hot melt composition comprising one or more block copolymers wherein at least one block comprises styrene, the adhesive composition further comprising at least one pharmacologically active substance.

38. The backing material of claim 37, wherein the number of stitches is from 5/cm to 50/cm.

39. The backing material of claim 37, wherein the nonwoven exhibits an ultimate tensile strength of at least 10 N/cm.

40. The backing material of claim 39, wherein the nonwoven exhibits an ultimate tensile strength of from 20 N/cm to 450 N/cm.

41. The backing material of claim 37, wherein the nonwoven exhibits an ultimate tensile strength of from 30 N/cm to 250 N/cm.

42. The backing material of claim 37, wherein fibers of the nonwoven exhibit a water retention capacity of from 3 % to 50 %.

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43. The backing material of claim 40, wherein the nonwoven exhibits an ultimate tensile stress elongation of less than 40 %.

44. The backing material of claim 37, wherein the nonwoven is reinforced with one or more of monofil fibers, multifil fibers, staple fibers, spun fiber yarns and oriented high-strength fibers, the fibers and yarns having a strength of at least 40 cN/tex.

45. The backing material of claim 37, wherein at least 20 % of one side of the nonwoven is coated with the adhesive composition.

46. The backing material of claim 45, wherein up to 95 % of one side of the nonwoven is coated with the adhesive composition.

47. The backing material of claim 37, wherein the backing material comprises the adhesive composition in an amount of more than 15 g/m².

48. The backing material of claim 38, wherein the backing material comprises the adhesive composition in an amount of from 90 g/m² to 500 g/m².

49. The backing material of claim 37, wherein the one or more block copolymers are selected from A-B and A-B-A block copolymers.

50. The backing material of claim 49, wherein block A comprises polystyrene and block B

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comprises one or more monomer units selected from ethylene, propylene, butylenes, butadiene and isoprene.

51. The backing material of claim 50, wherein a total concentration of styrene in the one or more block copolymers is less than 35 % by weight.

52. The backing material of claim 51, wherein the total concentration of styrene in the one or more block copolymers is from 5 % to 30 % by weight.

53. The backing material of claim 51, wherein the one or more block copolymers comprise at least one diblock copolymer and at least one triblock copolymer.

54. The backing material of claim 53, wherein a proportion of the at least one diblock copolymer is less than 80 % by weight.

55. The backing material of claim 37, wherein the adhesive composition comprises from 10 % to 90 % of block copolymers.

56. The backing material of claim 37, wherein the adhesive composition has a softening point of higher than 70°C.

57. The backing material of claim 56, wherein the adhesive composition has a softening point of from 80°C to 140°C.

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58. The backing material of claim 37, wherein the adhesive composition exhibits a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of lower than 15°C.

59. The backing material of claim 58, wherein the adhesive composition exhibits a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of from 3°C to -30°C.

60. The backing material of claim 37, wherein the adhesive composition comprises from 0.01 % to 60 % by weight of the at least one pharmacologically active substance.

61. The backing material of claim 55, wherein the adhesive composition comprises from 0.1 % to 20 % by weight of the at least one pharmacologically active substance.

62. The backing material of claim 37, wherein the adhesive composition is foamed.

63. The backing material of claim 37, wherein the adhesive composition is on one side of the nonwoven and the nonwoven is finished on a side opposite to the side of the adhesive composition with at least one of a water-repellent layer, an impregnation, a release layer and a coating.

64. The backing material of claim 37, wherein the backing material further comprises a wound pad or a padding on the adhesive composition.

65. The backing material of claim 37, wherein the backing material can be torn by hand at

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least one of perpendicular to an orientation of the stitches and in a direction of the stitches.

66. The backing material of claim 37, wherein at least a portion of the at least one pharmacologically active substance is not in co-mixture with the adhesive composition.

67. The backing material of claim 37, wherein the adhesive composition is sterilized.

68. The backing material of claim 37, wherein the at least one pharmacologically active substance comprises one or more of aceclidine, amfetaminil, amfetamine, amyl nitrite, apophedrin, atebaine, alpostadil, azulene, arecoline, anethole, amylene hydrate, acetylcholine, acridine, adenosine triphosphoric acid, l- malic acid, alimemazine, allithiamine, allyl isothiocyanate, aminoethanol, apyzine, apirole, azatadine, alprenolol, ethinazone, benzoyl peroxide, benzyl alcohol, bisabolol, bisnorephedrine, butacetoluide, benactyzine, camphor, colecalciferol, chloral hydrate, clemastine, chlorobutanol, capsaicin, cyclopentamine, clobutinol, chamazulene, dimethocaine, codeine, chloropromazine, quinine, chlorthymol, cyclophosphamide, cinchocaine, chlorambuzil, chlorphenesin, diethylethane, divinylethane, dexchlorpheniramine, dinoprostone, dixyrazine, ephedrine, ethosuximide, enallylpropymal, emylcamate, erythrol tetranitrate, emetine, enflurane, eucalyptol, etofenamate, ethylmorphine, fentanyl, fluanisone, guaiazulene, halothane, hyoscyamine, histamine, fencarbamide, hydroxycaine, hexylresorcin, isoaminile citrate, isosorbide dinitrate, ibuprofen, iodine, iodoform, isoaminile, lidocaine, lopirine, levamisole, methadone, methypylone, methylphenidate, mephenesine, methylephedrine, meclastine, methopromazine, mesuximide, nikethamide, norpseudoephedrine, menthol, methoxyfluran, methylpentinol, metixene, mesoprostol, oxytetracaine, oxyprenolol,

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oxyphenbutazone, oxyquinoline, pinene, prolintane, procyclidine, piperazine, pivazide, phensuximide, procaine, phenindamine, promethazine, pentetrazol, profenamine, perazine, phenol, pethidine, pilocarpine, prenylamine, phenoxybenzamine, resochin, scopolamine, salicylic acid ester, sparteine, trichlorethylene, timolol, trifluperazine, tetracaine, trimipramine, tranylcypromine, trimethadione, tybamate, thymol, thiondazine, valproic acid and verapamil.

69. A backing material for medical purposes, wherein the backing material comprises a nonwoven which is reinforced by stitches formed by loops from fibers of the nonwoven, a number of stitches being at least 3/cm of web, and an adhesive composition on at least a part of at least one side of the nonwoven, the adhesive composition being a hot melt composition comprising one or more block copolymers wherein at least one block comprises styrene, the adhesive composition further comprising at least one pharmacologically active substance.

70. The backing material of claim 69, wherein the number of stitches is from 5/cm to 50/cm.

71. The backing material of claim 69, wherein the nonwoven exhibits an ultimate tensile strength of at least 10 N/cm.

72. The backing material of claim 69, wherein the backing material generates a compression force of from 0.2 N/cm to 10 N/cm at an elongation of from 20 % to 70 %.

73. The backing material of claim 69, wherein fibers of the nonwoven exhibit a water retention capacity of from 3 % to 50 %.

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74. The backing material of claim 69, wherein the nonwoven is reinforced with one or more of monofil fibers, multifil fibers, staple fibers, spun fiber yarns and oriented high-strength fibers, the fibers and yarns having a strength of at least 40 cN/tex.

75. The backing material of claim 69, wherein at least 20 % of one side of the nonwoven is coated with the adhesive composition.

76. The backing material of claim 75, wherein up to 95 % of one side of the nonwoven is coated with the adhesive composition.

77. The backing material of claim 69, wherein the backing material comprises the adhesive composition in an amount of more than 15 g/m².

78. The backing material of claim 77, wherein the backing material comprises the adhesive composition in an amount of from 90 g/m² to 500 g/m².

79. The backing material of claim 69, wherein the one or more block copolymers are selected from A-B and A-B-A block copolymers.

80. The backing material of claim 79, wherein block A comprises polystyrene and block B comprises one or more monomer units selected from ethylene, propylene, butylenes, butadiene and isoprene.

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81. The backing material of claim 80, wherein a total concentration of styrene in the one or more block copolymers is less than 35 % by weight.

82. The backing material of claim 81, wherein the total concentration of styrene in the one or more block copolymers is from 5 % to 30 % by weight.

83. The backing material of claim 81, wherein the one or more block copolymers comprise at least one diblock copolymer and at least one triblock copolymer.

84. The backing material of claim 83, wherein a proportion of the at least one diblock copolymer is less than 80 % by weight.

85. The backing material of claim 69, wherein the adhesive composition comprises from 10 % to 90 % of block copolymers.

86. The backing material of claim 69, wherein the adhesive composition has a softening point of higher than 70°C.

87. The backing material of claim 86, wherein the adhesive composition has a softening point of from 80°C to 140°C.

88. The backing material of claim 69, wherein the adhesive composition exhibits a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of lower than 15°C.

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89. The backing material of claim 88, wherein the adhesive composition exhibits a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of from 3°C to -30°C.

90. The backing material of claim 69, wherein the adhesive composition comprises from 0.01 % to 60 % by weight of the at least one pharmacologically active substance.

91. The backing material of claim 85, wherein the adhesive composition comprises from 0.1 % to 20 % by weight of the at least one pharmacologically active substance.

92. The backing material of claim 69, wherein the adhesive composition is foamed.

93. The backing material of claim 69, wherein the adhesive composition is on one side of the nonwoven and the nonwoven is finished on a side opposite to the side of the adhesive composition with at least one of a water-repellent layer, an impregnation, a release layer and a coating.

94. The backing material of claim 69, wherein the backing material further comprises a wound pad or a padding on the adhesive composition.

95. The backing material of claim 69, wherein the backing material can be torn by hand at least one of perpendicular to an orientation of the stitches and in a direction of the stitches.

96. The backing material of claim 69, wherein at least a portion of the at least one
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pharmacologically active substance is not in co-mixture with the adhesive composition.

97. The backing material of claim 69, wherein the adhesive composition is sterilized.

98. The backing material of claim 69, wherein the at least one pharmacologically active substance comprises one or more of aceclidine, amfetaminil, amfetamine, amyl nitrite, apophedrin, atebine, alpostadil, azulene, arecoline, anethole, amylene hydrate, acetylcholine, acridine, adenosine triphosphoric acid, l- malic acid, alimemazine, allithiamine, allyl isothiocyanate, aminoethanol, apyzine, apiole, azatadine, alprenolol, ethinazone, benzoyl peroxide, benzyl alcohol, bisabolol, bisnorephedrine, butacetoluide, benactyzine, camphor, colecalciferol, chloral hydrate, clemastine, chlorobutanol, capsaicin, cyclopentamine, clobutinol, chamazulene, dimethocaine, codeine, chloropromazine, quinine, chlorthymol, cyclophosphamide, cinchocaine, chlorambuzil, chlorphenesin, diethylethane, divinylethane, dexchlorpheniramine, dinoprostone, dixyrazine, ephedrine, ethosuximide, enallylpropymal, emylcamate, erythrol tetranitrate, emetine, enflurane, eucalyptol, etofenamate, ethylmorphine, fentanyl, fluanisone, guaiazulene, halothane, hyoscyamine, histamine, fencarbamide, hydroxycaine, hexylresorcin, isoaminile citrate, isosorbide dinitrate, ibuprofen, iodine, iodoform, isoaminile, lidocaine, lopirine, levamisole, methadone, methyprylone, methylphenidate, mephenesine, methylephedrine, meclastine, methopromazine, mesuximide, nikethamide, norpseudoephedrine, menthol, methoxyfluran, methylpentinol, metixene, mesoprostol, oxytetracaine, oxyprenolol, oxyphenbutazone, oxyquinoline, pinene, prolintane, procyclidine, piperazine, pivazide, phensuximide, procaine, phenindamine, promethazine, pentetrazol, profenamine, perazine, phenol, pethidine, pilocarpine, prenylamine, phenoxybenzamine, resochin, scopolamine, salicylic

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acid ester, sparteine, trichlorethylene, timolol, trifluoperazine, tetracaine, trimipramine, tranylcypromine, trimethadione, tybamate, thymol, thiondazine, valproic acid and verapamil.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.